

REMARKS

These Remarks are in reply to the Office action mailed July 27, 2004. Claims 1, 6 and 9 are hereby amended and claim 12 has been canceled such that claims 1-11 and 13-18 remain pending.

Election Requirement

The Examiner is thanked for the withdrawal of the previous restriction requirement.

Objection to the Specification

The Examiner objected to the abstract on the grounds that it is "[not] directed to the claimed invention, i.e. manufacturing process." This objection is respectfully traversed, in that the abstract as filed clearly states that arm "edges are provided with stiffening elements" in accordance with the claimed manufacturing method. As such, the Abstract of the Disclosure has not been amended.

The Examiner objected to the title on grounds that it was not descriptive. The title has been amended above and is believed to overcome the objection.

Claim Rejections - 35 U.S.C. § 102

The Examiner rejected claims 1-6 and 9-18 under 35 U.S.C. § 102(b) as being anticipated by WIPO publication WO 99/09544 (hereinafter "the '544 document").

Claim 1 as amended requires that a stiffening element be provided which protrudes from the actuator arm. The '544 document, according to the Office, discloses only stiffening elements 560-568 which are internal to the arm and cannot therefore be reasonably construed as protruding from the arm. For at least this reason, the '544 document does not anticipate claim 1. Withdrawal and allowance of claim 1 is respectfully requested.

Claims 2-6 depend from claim 1 and are allowable for at least this reason. Some of these claims are allowable for additional reasons as well.

As to claim 4, while the Office suggests on page 3 of the action that the integrally molded carbon fibers of the '544 document can be read as a "rails" this is simply not the case, as any reading of the specification or other definitions make clear. If the Office continues to maintain the rejection of claim 4, Applicant respectfully requests production of some evidence suggesting that such a fiber can constitute a rail as claimed.

Claim 5 requires that the stiffening element be planar. The linear fibers of the '544 document are clearly incapable of defining a plane.

Claim 6 as amended requires that the arm and stiffening elements be formed of a single, continuous piece of material. The fibers and arm of the '544 document are clearly made of different, discrete materials.

For at least these reasons, withdrawal of the rejection of claims 2-6 and allowance thereof are respectfully requested.

Claim 9 as amended requires that the arm and stiffening elements be formed of a single, continuous piece of material. The fibers and arm of the '544 document are clearly made of different, discrete materials. For at least this reason, the '544 document does not anticipate claim 9. Withdrawal and allowance of claim 9 is respectfully requested.

Claims 10, 11, 13 and 14 depend from claim 9 and are allowable for at least this reason. Some of these claims are allowable for additional reasons as well.

Claim 10 as amended requires that a stiffening element be provided which protrudes from the actuator arm. The '544 document, according to the Office, discloses only stiffening elements 560-568 which are internal to the arm and cannot therefore be reasonably construed as protruding from the arm.

As to claim 11, while the Office suggests on page 3 of the action that the integrally molded carbon fibers of the '544 document can be read as a "rails" this is

simply not the case, as any reading of the specification or other definitions make clear. If the Office continues to maintain the rejection of claim 11, Applicant respectfully requests production of some evidence suggesting that such a fiber can constitute a rail as claimed.

For at least these reasons, withdrawal of the rejection of claims 10, 11, 13 and 14 and allowance thereof are respectfully requested.

Claim 15 recites the limitation "a step for tuning a first natural resonant frequency of an actuator arm while minimizing change to a second natural resonant frequency of the arm." This claim thus invokes 35 U.S.C. § 112, sixth paragraph. Whatever the result may have been under prior PTO practice, the PTO must construe functional limitations in accordance with the corresponding method disclosed in the specification when examining patents. In re Donaldson, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994) (en banc). Applicant's corresponding process, at the least, includes providing a stiffening element protruding from an edge of an arm. The '544 document does not disclose this process. For at least this reason, claim 15 is believed to be allowable over prior art, and withdrawal of the rejection is respectfully requested.

Claims 16-18 depend from claim 15 and are similarly allowable.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 7 and 8 under 35 U.S.C. § 103 as being obvious over the '544 document.

Claims 7 and 8 depend from allowable claim and are themselves allowable for at least this reason.

Conclusion

Applicant respectfully asserts that present claims particularly point out and distinctly claim the subject matter which is regarded as the invention. In addition, the present invention as claimed is not taught by the prior art of record or any combination thereof. Therefore, it is respectfully submitted that the pending claims are in condition for allowance, and favorable action with respect to the present application is respectfully requested.

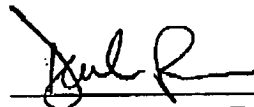
If the Examiner is not satisfied, but minor changes would apparently put the present case in condition for allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

Seagate Technology LLC
(Assignee of the Entire Interest)

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Date



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